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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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08/957,911 10/27/97 HOOD

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GM41/0930
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EXAMINER

HARRIS-OGUGUA, S

ART UNIT

PAPER NUMBER

3736

DATE MAILED:

09/30/98

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on 5-26-98, as Paper #5
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 11-21 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 11, 13, 14, 16 and 18-20 is/are rejected.
- ☒ Claim(s) 12, 15, 17 and 21 is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

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Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 11, 13, 14, 16 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schachar.

Schachar discloses an ophthalmic probe device as claimed having a tip 62, a stop (distal, edge end of 32), a handle 32, a first connector 36, a second connector 38 and a power supply 40. However, Schachar fails to disclose the length the tip extends, as recited in claims 13 and 18; also there is no mention of power wattage per duration period as recited in claim 16.

To have provided Schachar with the tip lengths of the present invention would have been an obvious modification for facilitating safety considering that Schachar's probe device is also disclosed as being used on the cornea.

In as much as it is well known to vary electrical operating parameters as required by need,, to have provided Schachar with the particulars of wattage and duration would have been obvious depending on the surgical outcomes desired.

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Allowable Subject Matter

3. Claims 12, 15, 17 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

4. The following is a statement of reasons for the indication of allowable subject matter:

5. There is no teaching in the prior art of a tip for insertion within the cornea having a dielectric band or being connected to the end of a spring beam; and there is no teaching of a grounding pad.

The applied primary reference teaches of a monopolar device..

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Epstein, Doss '007, Berry et al and Brown all show ophthalmic devices.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sonya Harris-Ogugua whose telephone number is (703) 308-2216. The examiner can normally be reached on Mondays to Thursdays from 8:30 am to 6:00 pm.


The fax phone number for this Group is (703) 308-3139.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0858.


S.Harris-Ogugua

September 25, 1998


Max Hindenburg
Primary Examiner